

## **REMARKS**

By this Amendment, Applicant has cancelled claims 13, 26, and 28-77, without prejudice or disclaimer, amended claims 1, 14, and 25, and added new claims 78-87. The originally filed specification, drawings, and claims fully support the subject matter of amended claims 1, 14, and 25 and new claims 78-87. Accordingly, claims 1-12, 14-25, and 78-87 remain pending in this application. Applicant requests the prompt re-examination and allowance of this application.

### **Objection to the Drawings**

On pages 2-3 of the Office Action, the drawings were objected to under 37 CFR 1.121(d) for allegedly submitting replacement sheets for Figures 1-9B but not Figures 10A-C. As indicated on the accompanying filing receipt, Figures 10A-C were included in the replacement drawings submitted on September 10, 2003. In an effort to advance prosecution, Applicant herewith resubmits Figures 10A-C. Accordingly, Applicant respectfully requests entry of the replacement drawings and the withdrawal of the objection to the drawings.

### **Objection to the Specification**

On page 3 of the Office Action, the specification was objected to because of a series of informalities. Applicant amends the specification by submitting a substitute specification labeled SUBSTITUTE SPECIFICATION and a comparison specification labeled COMPARISON SPECIFICATION identifying the changes in the SUBSTITUTE SPECIFICATION that were made in comparison to the originally filed specification, in accordance with MPEP §1.125(b and c). Applicant submits that the specification

contains no new matter. Applicant respectfully requests entry of the Substitute Specification and withdrawal of the specification objection.

### **Claims Objection**

On page 4 of the Office Action, claim 25 was objected to because of the following informality: it uses the elongated container to define itself. Applicant has amended claim 25 and has changed “defines” to “includes” as the examiner has suggested. Accordingly, Applicant respectfully requests withdrawal of the claim rejection.

### **Anticipation Rejection**

On pages 4-6 of the Office Action, claims 14-20 and 22-26 are rejected under 35 U.S.C. §102(b) as being anticipated by International Publication Number WO 01/30242 to Paternuosto et al. (“Paternuosto”). Applicant respectfully traverses this rejection. A proper anticipation rejection requires each and every element set forth in the claim to be found in a single prior art reference. See MPEP § 2131. The anticipation rejection set forth in the outstanding Office Action does not properly establish that each and every claimed element is disclosed in Paternuosto.

Paternuosto discloses forceps for medical use comprising of two half shells 10a, 10b which are mounted on a support element 16 in a manner such that they can adopt a first, opened-out configuration and a second, closed configuration. See Fig. 1 and last paragraph of page 3 of Paternuosto. The half-shell 10b, has in its base wall 14, a hole 18 which communicates with the cavity 20 inside a beaker-shape container element 22 to receive a plurality of biopsy samples. See Fig. 3 and paragraph 4 of page 5 of Paternuosto. The beaker-shaped container element 22 is fixed to the base wall 14, such that the internal cavity of the container element constitutes a continuation of the

space inside the half-shell 10b. The beaker shaped container element 22 has a restricted neck below hole 18 to permit the passage of biopsy samples towards cavity 20. See Fig. 7 and paragraph 4 of page 5 of Paternuosto. The Examiner asserts that the walls of container element 22 form an hour-glass shape immediately above and below the restricted neck below to hole 18. See paragraph 6 of page 6 of the Office Action.

Claim 14, on the other hand, recites a device for storing a plurality of tissue samples including, *inter alia*, "an elongate container having a cavity for storing a plurality of tissue samples, an open top, and an open bottom in flow communication with the open top ... wherein a portion of the elongate container adjacent the open bottom has an hour-glass shape configured to prevent the plurality of samples from exiting the container via the open bottom." Even if the walls of container element 22 form an hour-glass shape immediately above and below the hole 18, which the Applicant does not necessarily concede, Paternuosto discloses a container element 22 with a restricted neck that must permit the passage of biopsy samples, opposite to that claimed. Accordingly, Applicant submits that independent claim 14 is allowable for at least this reason. Additionally, claims 15-26 and 83-87 depend from claim 14 and are allowable for at least this reason.

### **Obviousness Rejections**

On pages 7-12 of the Office Action, claims 1-7, 9-13, and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paternuosto. A proper *prima facie* case of obviousness requires, *inter alia*, the prior art reference must teach or suggest all the claim limitations. See MPEP § 2142. Applicant respectfully traverses this rejection.

Claim 1 recites a device for storing a plurality of tissue samples including, *inter alia*, “an elongate container having a cavity for storing a plurality of tissue samples, an open top, and an open bottom in flow communication with the open top... a portion of the elongate container adjacent to the open bottom having an hour-glass shape defining a restriction smaller than the open bottom to prevent the plurality of tissue samples from exiting the container via the open bottom.”

As set forth above, Paternuosto discloses a container element 22 having a cavity 20 for receiving a plurality of biopsy samples. The container 22 includes a plurality of openings 24 in its base and side walls to discharge air and organic liquids trapped within the cavity 20. See Fig.7, paragraph 6 of page 4, and paragraph 5 of page 5 of Paternuosto. In the Office Action, the Examiner contends that although Paternuosto does not disclose an elongate container having an hour-glass shape defining a restriction smaller than the open bottom configured to prevent the plurality of tissue samples from exiting the container, it would have been obvious to one of ordinary skill of the art that such a change in shape would perform the same function as disclosed in Paternuosto. See paragraph 3 of page 8 of the Office Action. The Applicant respectfully disagrees. Those skilled in the art would not be motivated to make such a change in shape to container element 22 to allow fluid to flow through while retaining the biopsy samples.

Specifically, Paternuosto discloses a container element with an opening within the base wall to permit the discharge of organic liquids trapped within cavity 20 and, as asserted by the Examiner in the Office Action, the portion of the container element 22 adjacent to opening 24 already would prevent the plurality of tissue samples from

exiting the container element. See paragraph 2 of page 8 of the Office Action. It is unclear, then, why one of ordinary skill in the art would be motivated to modify the container element 22 as proposed by the Office Action.

In addition, if container element 22 were modified to include an hour-glass shape with a restriction smaller than opening 24, the container element would have less volume thereby decreasing the number of samples retained during a single biopsy procedure. This would be contrary to the intent of Paternuosto, which seeks to “take all the samples necessary...by performing only one introduction and withdrawal.” See paragraph 4 of page 2 of Paternuosto. For this additional reason, therefore, one of ordinary skill in the art would not be motivated to modify container element 22 as suggested in the Office Action.

Furthermore, the unique claimed structure can have the advantage of being able to mate with an appropriate flushing device for removal of biopsy samples. This feature has been included in new dependent claim 78, which recites a device of claim 1, “wherein the portion of the elongate container adjacent to the open bottom is configured to mate with a flushing device.”

Accordingly, Applicant submits that independent claim 1 is allowable for at least these reasons. Additionally, claims 2-13 and 78-82 depend from claim 1 and are allowable as each of these dependent claims recites unique combinations that are neither taught nor suggested by the prior art.

#### **New Claims**

New claims 79-82 and 84-87 further recite various features of the protrusion extending around an edge of the upper jaw. Specifically they recite one or more of:

“wherein the protrusion is adjacent to the outer edge of the upper jaw;” “wherein the protrusion is oval shaped;” “wherein the protrusion surrounds an inner non-protruding portion;” and “ wherein the inner non-protruding portion defines at least one ventilating hole.” In contrast, Paternuosto discloses a half shell 10a having a central portion 26 that is raised substantially to the level of the rim, and an annular, recessed, peripheral portion 28. See Fig. 6 and paragraph 3 of page 5 of Paternuosto. That is, Paternuosto does not disclose a protrusion having any of the features recited in claims 79-82 and 84-87. Accordingly, Applicant submits that these dependent claims are allowable for at least this reason.

### **CONCLUSION**

In view of the foregoing remarks, the Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification and claims in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 24, 2007

By: \_\_\_\_\_

  
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